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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/647,425

08/25/2003

John McFarland Harris

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EXAMINER

CHURNET, DARGAYE H

ART UNIT

PAPER NUMBER

2616

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
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3 MONTHS

04/19/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/19/2007.

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Office Action Summary	Application No.	Applicant(s)	
	10/647,425	HARRIS ET AL.	
	Examiner	Art Unit	
	Dargaye H. Churnet	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/16/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Claim Objections

1. Claims 1, 2, 6, 7, 10, and 14 are objected to under 37 C.F.R. 1.75 because of the following formalities:

In claim 1, line 3, the occurrence of "a destination mobile unit" seems to refer back to "a destination mobile unit" previously recited in line 2. If this is true, it is suggested to change "a destination mobile unit" to ---the destination mobile unit---.

In claim 1, line 4, the occurrence of "information" seems to refer back to "information" previously recited in line 1. If this is true, it is suggested to change "information" to ---the information---.

In claim 2, line 2, the occurrence of "a wireless connection" seems to refer back to "a wireless connection" previously recited in claim 1. If this is true, it is suggested to change "a wireless connection" to ---the wireless connection---. Claims 6 and 10 are objected to for similar reasons.

In claim 7, line 1, the occurrence of "at least one data burst message" seems to refer back to "at least one data burst message" previously recited in claim 1. If this is true, it is suggested to change "at least one data burst message" to ---the at least one data burst message---.

In claim 14, line 3, the occurrence of "a source mobile unit" seems to refer back to "a source mobile unit" previously recited in line 1. If this is true, it is suggested to change "a source mobile unit" to ---the source mobile unit---.

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In claim 14, line 8, the occurrence of "a destination mobile unit" seems to refer back to "a destination mobile unit" previously recited in line 2. If this is true, it is suggested to change "a destination mobile unit" to ---the destination mobile unit---.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 8, 13-15, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (cited 6,728,365 B1).

For claim 1, Li et al. disclose a method for transmitting information from a sender at a source mobile unit to a recipient at a destination mobile unit, the method comprising: selecting a destination mobile unit (see col. 6, lines 21-25, wherein MT 16 is the source mobile unit, and second terminal 18 is the destination mobile unit); forming an overture element, the overture element containing information from the sender at the source mobile unit indicating that the sender desires to establish a wireless connection with the recipient at the destination mobile unit (see col. 4, lines 25-30, wherein the PATH message initiates communication between the source and destination in the wireless network); and forming at least one data burst message incorporating the

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overture element (see col. 8, lines 56-58, wherein data bursts are sent as PATH messages). Claims 8 and 14 are rejected for similar reasons.

For claim 2, Li et al. disclose establishing a wireless connection between the source mobile unit and the destination mobile unit; and transmitting the at least one data burst message over the wireless connection to the destination mobile unit (see col. 17, lines 44-49, wherein data bursts are transmitted to initiated a traffic channel).

For claim 3, Li et al. disclose receiving the data burst message at the destination mobile unit; extracting the overture element from the at least one data burst message; and evaluating the information in the overture element; and determining whether to establish the wireless connection based upon the information in the overture element (see col. 11, lines 51-63, wherein either PATH messages or data bursts may be sent to the receiver 18, and upon receipt, the receiver sends a RESV message to satisfy communication quality).

For claim 7, Li et al. disclose forming at least one data burst message comprises forming two or more data burst messages (see col. 8, lines 56-58, wherein short data bursts are transmitted, meaning two or more data burst messages). Claims 13 and 15 are rejected for similar reasons.

For claim 17, Li et al. disclose the wireless telecommunication infrastructure transmitting the data burst message according to the CDMA 2000 protocol (see col. 6, lines 6-9, wherein cdma2000 protocol is used).

For claim 18, Li et al. disclose the destination mobile unit operates in a plurality of call-processing states and sub-states, at least one of which is a waiting for order sub-state, and the destination mobile unit is operating in the waiting for order sub-state during the receipt of the at least one data burst message (see col. 8, lines 19-24, wherein there are many different states and the waiting for order sub-state is represented by the dormant state).

Claim Rejections - 35 USC § 103

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 9, 10, 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. in view of Valentine et al. (cited 6,088,589).

For claim 4, Li et al. disclose all the subject matter of the claimed invention with the exception of the forming the overture element comprising forming a voice message. Valentine et al. from the same or similar fields of endeavor teach the forming the overture element comprising forming a voice message (see col. 10, lines 18-19, wherein a voice message is played). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. can be modified/implemented into the network of Li et al. by playing a voice message. The motivation for the forming the overture element comprising forming a voice message is

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to distinguish the source mobile unit to the destination mobile terminal. Claim 9 is rejected for similar reasons.

For claim 5, Li et al. disclose all the subject matter of the claimed invention with the exception of the evaluating the information in the overture element comprising playing the voice message to the recipient and wherein determining whether to establish a wireless connection comprises waiting a predetermined period of time for the recipient to initiate the formation of a response. Valentine et al. from the same or similar fields of endeavor teach the evaluating the information in the overture element comprising playing the voice message to the recipient and wherein determining whether to establish a wireless connection comprises waiting a predetermined period of time for the recipient to initiate the formation of a response (see col. 10, lines 16-25, wherein a mobile station plays a voice message to a destination in regards to establishing a connection between the two). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. can be modified/implemented into the network of Li et al. by sending a voice message from the source to the destination. The motivation for the evaluating the information in the overture element comprising playing the voice message to the recipient and wherein determining whether to establish a wireless connection comprises waiting a predetermined period of time for the recipient to initiate the formation of a response is to establish a wireless connection. Claim 10 is rejected for similar reasons.

For claim 6, Li et al. disclose all the subject matter of the claimed invention with the exception of establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection. Valentine et al. from the same or similar fields of endeavor teach establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection (see col. 8, lines 16-19, wherein a call is placed only if the destination accepts it). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. can be modified/implemented into the network of Li et al. by waiting for a response from the destination. The motivation for establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection is to have both parties available for the call.

For claim 19, Li et al. disclose the transmission of data bursts that comprise the communication request output. Li et al. disclose all the subject matter of the claimed invention with the exception of a two-way wireless communication device comprising: a wireless transceiver having at least a data burst output; a user interface that comprises at least an audio input; a voice message storage unit operably coupled to the user interface; at least one register containing an address for a destination mobile unit; a

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controller that is operably coupled to the user interface, the voice message storage unit, and the at least one register and having a communication request output comprising at least a portion of the contents of the at least one register and at least a portion of a voice message as stored in the voice message storage unit, wherein the communication request output is operably coupled to the wireless transceiver. Valentine et al. from the same or similar fields of endeavor teach the device above (see col. 4, lines 12-15, wherein the mobile stations can be portable phones, and portable phone has the elements of the claimed device). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. can be modified/implemented into the network of Li et al. by using a portable phone, which is very well known in the art. The motivation for using portable phones is to communicate between multiple users.

For claim 20, Li et al. disclose controller means for forming an overture element, the overture element containing information from the sender at the source mobile unit indicating that the sender desires to establish a wireless connection with the recipient at the destination mobile unit (see col. 4, lines 25-30, wherein the PATH message initiates communication between the source and destination in the wireless network)

For claim 21, Li et al. disclose the controller comprising controller means for forming at least one data burst message incorporating the overture element (see col. 8,

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lines 56-58, wherein short data bursts are transmitted, meaning two or more data burst messages)

For claim 22, Li et al. disclose the transmission of data bursts that comprise the communication request output. Li et al. disclose all the subject matter of the claimed invention with the exception of a call initiation mechanism at a destination mobile unit comprising: a wireless transceiver having at least a data burst input from a source mobile unit; a voice message storage unit operably coupled to the wireless transceiver; an interface having an audio output; a controller that is operably coupled to the voice message storage unit, and having a communication output comprising at least a portion of at least one data burst message as stored in the voice message storage unit, the controller being coupled to the interface by the communication output. Valentine et al. from the same or similar fields of endeavor teach the device above (see col. 4, lines 12-15, wherein the mobile stations can be portable phones, and portable phone has the elements of the claimed device). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. can be modified/implemented into the network of Li et al. by using a portable phone, which is very well known in the art. The motivation for using portable phones is to communicate between multiple users. Similarly, claims 23 and 24 are rejected as a portable phone would obviously have a control input to answer a call and a means for establishing an interconnect call between two users.

6. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. in view of Valentine et al. as applied to claims 4-10 above, and further in view of Schmidt (cited 6,018,668).

For claim 11, Li et al. in view of Valentine et al. disclose all the subject matter of the claimed invention with the exception of muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit. Schmidt from the same or similar fields of endeavor teaches muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit (see col. 3, lines 4-7, wherein the mobile station mutes a microphone). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Schmidt in the network of Li et al. in view of Valentine et al. The method taught by Schmidt can be modified/implemented into the network of Li et al. in view of Valentine et al. by muting a microphone. The motivation for muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit is to stop listening to the voice message.

For claim 12, Li et al. disclose all the subject matter of the claimed invention with the exception of establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection.

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Valentine et al. from the same or similar fields of endeavor teach establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection (see col. 8, lines 16-19, wherein a call is placed only if the destination accepts it). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Valentine et al. in the network of Li et al. The method taught by Valentine et al. can be modified/implemented into the network of Li et al. by waiting for a response from the destination. The motivation for establishing an interconnect call between the source mobile unit and the destination mobile unit if the recipient determines to establish a wireless connection is to have both parties available for the call.

7. Claims 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. in view of Schmidt.

For claim 16, Li et al. disclose all the subject matter of the claimed invention with the exception of muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit. Schmidt from the same or similar fields of endeavor teaches muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit (see col. 3, lines 4-7, wherein the mobile station mutes a microphone). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to incorporate the elements above stated by Schmidt in the network of Li et al. The

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method taught by Schmidt can be modified/implemented into the network of Li et al. by muting a microphone. The motivation for muting a microphone at the destination mobile unit when the recipient establishes the wireless connection with the source mobile unit is to stop listening to the voice message.

Conclusion

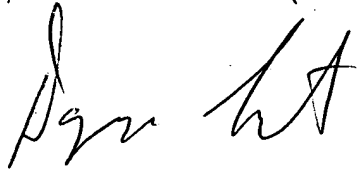
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references include Kung et al. (cited 6,252,952 B1) and Gelman et al. (cited 6,415,329 B1).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dargaye H. Churnet whose telephone number is 571-270-1417. The examiner can normally be reached on Monday-Friday from 7:30-5:00.

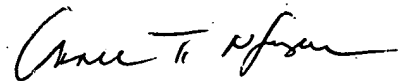
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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